

REMARKS

This is in response to the Office Action mailed August 18, 2009. For at least the reasons stated below, Applicants submit that all pending claims are in condition for allowance.

By way of the present Response, Applicants hereby amend claims 1, 4, 5 and 33 and add claims 34-41. Claims 1, 4, 5 and 33 are amended to further clarify and emphasize that the user context information that is obtained “indicates the context of the activities of the user.” Claims 1, 4 and 5 are additionally amended to explicitly note that arranging for the presentation of an advertisement to the user is “based on the match indicating the user context information matches the advertiser offer conditions and the advertisee offer conditions.” Claim 1 is further amended to include steps electronically performed by a processing device. These amendments do not add any new matter beyond the specification as originally filed and as such, Applicants request entrance and examination.

Claims 34-41 are the re-introduction of previously pending claims and additional claim amendments relate to correcting dependency and typographical issues.

Applicants note that claims 8-10, 21-22, 24, 26 and 30 were previously cancelled without prejudice in order to comply with the previous amended version of 37 CFR 1.75(b). In view of the fact that the USPTO has been permanently enjoined from implementing the previous amended version of 37 CFR 1.75(b), making the previous amended version of 37 CFR 1.75(b) void, Applicants have added new claims 34-41, which reintroduce previously cancelled claims 8-10, 21-22, 24, 26 and 30, respectively.

Claims 1-3 stand rejected under 35 U.S.C. §101 as not being directed to statutory subject matter. Claim 1, as amended, recites a computerized method and includes steps electronically performed. Therefore, claim 1 clearly satisfies at least the machine prong of the machine-or-transformation test, rendering the present rejection improper.

Claims 1-7, 11-15, 19, 20, 23, 25, 29 and 31-33 stand rejected under 35 U.S.C. 102(c) as being anticipated by U.S. Patent Publication No. 2004/0103024 to Patel, et al. (“Patel”). Applicants respectfully disagree and traverse because Patel fails to identically disclose all of the claimed elements.

Patel, as understood, discusses an inverted CPA model as applied to advertisers and publishers. (§ [0038], lines 1-7) Offers are created by advertisers, detailing prices that they are willing to pay for actions so that a publisher places an ad on their site. The offers are listed on an “exchange system” where the publishers review the offers and select the ones that are most appropriate. (§ [0038], lines 7-12) The “exchange system” “creates a potentially unlimited number of registered Advertisers with the ability to make potentially unlimited numbers of variable offers to compensate a potentially unlimited number of publishers for actions performed as a result of media run on publishers’ sites (§ [0045], lines 1-7)

In contrast, claim 1 expressly recites, *inter alia*, “obtaining an advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user” and “electronically, via the processing device, arranging for presentation of the advertisement to the user based on the match indicating the user context information matches at least one of the advertiser offer conditions or the advertisee offer conditions.”

Patel fails to identically disclose, *inter alia*, “obtaining an advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user.” A publisher offers ad space to advertisers at a particular performance rate, in an environment known as the “CPA” model. (Patel, ¶ [0030]) However, these offers do not make up an advertisee offer comprising a set of requirements of one or more user context conditions. Instead, these are offers of advertising space of a certain performance level at a certain price. Therefore, Patel does not have “an advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user.”

Patel also fails to disclose “electronically, facilitating, via the processing device, arranging for presentation of the advertisement to the user based on the match” as claimed. A publisher will try to satisfy certain specifications as requested by advertisers. (Patel, ¶ [0018], lines 4-6) Advertiser specifications may include, a guaranteed delivery of a specific number of impressions within a certain time, the frequency a single viewer will see the ad in a certain period, the location of the ads on a site and within a page, target audience specification. (¶ [0014] through [0017]) In order to meet such requirements, Patel discusses that the publisher organizes the layout of their pages to satisfy advertisers that the requested specifications are being met. (Patel, ¶ [0018], lines 4-9) This organization of layout is solely based on the publisher trying to meet the advertiser’s conditions as opposed to a match between an advertiser offer, an advertisee offer and the user context information including “user activity corresponding to a given one or more user context conditions.”

Furthermore, **there is not even a matching between an advertiser offer and an advertisee offer.** Patel discusses the CPA model versus an inverted CPA model. (Patel, ¶ [0038]) In either model, only one side of a given advertiser/publisher party pair provides an offer to the other party. Patel's "exchange system" operates in an inverted CPA model environment, where a publisher offers ad space to advertisers.

While Applicants assert that the claims, prior to the amendments, were patentable, clarifying language has been amended herein to further emphasize the patentable distinction, to the Examiner, between Patel and the presently claimed invention. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claims 1, 4, 5 and 33 and allowance of the same.

Applicants additionally note that Patel is commonly-owned, as indicated on page 7, lines 15-19 of the originally-filed specification. Applicants submit that Patel is not a valid prior art reference under 35 U.S.C. §102(e) because Patel does not identically disclose all of the recited limitations. Additionally, Patel is not a valid prior art reference for use in a 103(a) obviousness rejection as per 35 U.S.C. §103(c).

The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over Patel and the prior art of record. Given the Applicants' position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants' undersigned representative to discuss any issues relating to this application.

Respectfully submitted,



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